

**Notice of Allowability**

Application No.

10/695,657

Examiner

Arnel C. Lavarias

Applicant(s)

GLUCH ET AL.

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 2/21/06, 1/17/06.
2. ☒ The allowed claim(s) is/are 1-7, 10-12 (renumbered 1-10).
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of the:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |   |   |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892)  | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)           |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                | 6. <input type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date _____ |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),<br>Paper No./Mail Date _____ | 7. <input type="checkbox"/> Examiner's Amendment/Comment                              |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material          | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance  |
|   | 9. <input type="checkbox"/> Other _____   |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/17/06 has been entered.

### ***Response to Amendment***

2. The amendments to Claim 1 in the submission dated 1/17/06 are acknowledged and accepted.
3. The cancellation of Claims 8-9 in the submission dated 1/17/06 is acknowledged and accepted.

### ***Response to Arguments***

4. With regard to Applicants' argument that Ursinus fails to teach or reasonably suggest an attachment device for the illumination system (See Pages 5-6 of Applicants' response dated 1/17/05), the Examiner respectfully disagrees. As previously stated in Section 7 of the Office Action dated 10/17/05, Ursinus discloses a means for attaching an electric lamp (See e, e' in Figure 11) to the objective lens (See b, b' in Figure 11). As clearly

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shown in Figure 11, the shade enclosing the electric lamp is directly attached to the objective. Further, Ursinus discloses additional embodiments similar to Figure 11 (e.g. Figures 2, 5-7, 10) that show attachment devices for attaching the electric lamps to the comparison microscope.

5. With regard to Applicants' argument that Scouten et al. is non-analogous art (See Pages 6-7 of Applicants' response dated 1/17/05), the Examiner respectfully disagrees. In particular, it is noted that Scouten et al. is analogous art in so far as the devices disclosed by Scouten et al. are utilized alongside with a microscope system (See for example Paragraph 0057; 0121 of Scouten et al.). Scouten et al., as with Ursinus, Mori, and Zeiss, are all within the same field of endeavor, i.e. microscopy.
6. With regard to Applicants' argument that there is no motivation to combine Zeiss with Scouten et al. (See Page 7 of Applicants' response dated 1/17/05), the Examiner respectfully disagrees. As per MPEP 2136.02 and 2141.01, Applicants are reminded that subject matter that is prior art under 35 U.S.C. 102 (this includes 35 U.S.C. 102(a), 102(b), and 102(e)) can be used to support a rejection under 35 U.S.C. 103. Since Scouten et al. is applicable as prior art under 35 U.S.C. 102(e), it is inappropriate to compare the publication date of Scouten et al. with the effective filing date of the instant application.
7. With respect to Applicants' arguments that Ursinus, Mori, Zeiss, Scouten et al., and Bacus et al. fail to teach or reasonably suggest the optimal illumination conditions being determined based on values of at least one scale and stored in a file together with image data of the specimens to be compared, wherein the stored values of at least one scale are

retrieved together with the image data. After reviewing the Ursinus, Mori, Zeiss, Scouten et al., and Bacus et al. references, the Examiner agrees, and respectfully withdraws the rejections in Sections 7-13 of the Office Action dated 10/17/05.

***Allowable Subject Matter***

8. Claims 1-7, 10-12 are allowed.

**REASONS FOR ALLOWANCE**

9. The following is an examiner's statement of reasons for allowance:

Claim 1 is allowable over the cited art of record for at least the reason that the cited art of record fails to teach or reasonably suggest a comparison optical system, as generally set forth in Claim 1, the comparison microscope including, in combination with the features recited in Claim 1, at least one scale is disposed on each movable arm, and the optimal illumination conditions being determined based on values of at least one scale and stored in a file together with image data of the specimens to be compared, wherein the stored values of at least one scale are retrieved together with the image data. Claims 2-7, 10-12 are dependent on Claim 1, and hence are allowable for at least the same reasons Claim 1 is allowable.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arnel C. Lavarias whose telephone number is 571-272-2315. The examiner can normally be reached on M-F 9:30 AM - 6 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Arnel C. Lavarias  
Patent Examiner  
Group Art Unit 2872  
4/19/06